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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,233	08/29/2005	Alexander B. Rossi	375462-003US	6779
37509 7590 09/05/2007 DECHERT LLP P.O. BOX 390460 MOUNTAIN VIEW, CA 94039-0460			EXAMINER BELYAVSKIY, MICHAEL A	
			ART UNIT 1644	PAPER NUMBER
			MAIL DATE 09/05/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/524,233

Applicant(s)

ROSSI, ALEXANDER B.

Examiner

Michail A. Belyavskyi

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 11-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-30 are pending.

2. Applicant's election with traverse of Group I, claims 1-10 in the reply filed on 06/21/07 is acknowledged. Applicant's traversal is on the grounds that the entire restriction requirement be reconsidered because the present application is a national phase application under 37 C.F.R. § 371 and no unity of invention issue was raised during prosecution of original claims 1-30 in the PCT application by either the International Search Authority or the International Preliminary Examination Authority. This is not found persuasive because Applicant's inventions do not contribute a special technical feature as set forth in the previous Office Action.

Applicants are reminded that the findings and opinion of the PCT examining authority is not controlling authority for the USPTO.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 11-30 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to nonelected inventions.

*Claims 1-10 read on a method of identifying a compound capable of modulating Fcγ receptor signaling pathways are under consideration in the instant application.*

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention *to which the claims are directed*.

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112.

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

6. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is resolution step: it is unclear how to identify a compound capable of modulating Fcγ receptor signaling pathways after performing method steps as recited in said claims. The minimum requirements for method steps minimally include a contacting step in which the reaction of the sample with the reagents necessary for the assay is recited, a detection step in which the reaction steps are quantified or visualized, and a correlation step describing how the results of the assay allow for the determination.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e2) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 37(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 03/074652 (IDS) as is evidenced from the instant Specification on pages 13, paragraph 0041 and 31, paragraph 0096.

WO' 652 teaches a method of identifying a compound capable of modulating mast cell degranulation ( see entire document Abstract and pages 5 and 6 in particular). WO' 652 teaches that mast cell is a human mast cell ( see page 5 in particular). WO' 652 teaches that a compound is a small organic compound that has a molecular weight in a range about 100 to 2500 daltons ( see page 9 in particular). WO' 652 teaches that prior of contacting mast cells with a candidate compound, mast cells are incubated in the presence of IgE, IgE antibody or combination of IgE and IgE antibody ( see overlapping pages 26 and 27 in particular). The Specification on pages 13, paragraph 0041 and 31, paragraph 0096, disclosed that priming of master cells is done by incubation with IgE or IgE antibody.

WO' 652 does not explicitly teaches that the claimed method would identifying a compound capable of modulating Fcγ receptor signaling pathways. However, it is noted that the CAFC recently held in Bristol-Myers Squibb Co. v. Ben Venue Laboratories Inc., 58 USPQ2d 1508 (CA FC 2001) that when a claimed process is not directed to a new use, *consists of the same steps described in a prior art reference*, and the newly discovered results of the known process *directed to the same purpose* are inherent, the process is not patentable.

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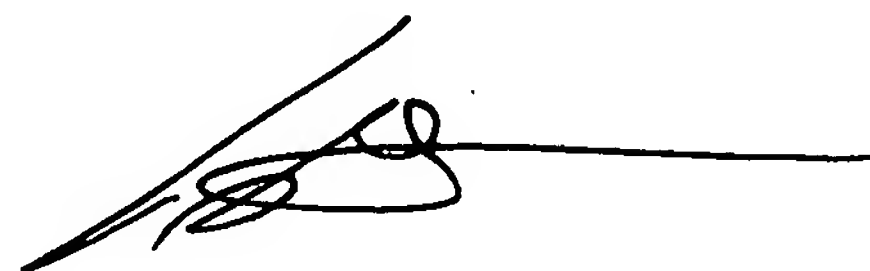
The reference teaching anticipates the claimed invention.

9. No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michail Belyavskyi whose telephone number is 571/272-0840. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:30 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571/272-0841.

The fax number for the organization where this application or proceeding is assigned is 571/273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MICHAIL BELYAVSKYI, PH.D.  
PATENT EXAMINER

08/30/07